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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,887	01/25/2002	Ryoichi Nadachi	1712652	8222

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EXAMINER	
GLASS, RUSSELL S	
ART UNIT	**PAPER NUMBER**
3626	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/031,887	NADACHI ET AL.	
	Examiner	Art Unit	
	Russell S. Glass	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 May 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,6,8-13,17 and 19-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,6,8-13,17 and 19-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. **Claims 1, 2, 6, 8-13, 17, 19-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.** In particular, the claims recite limitations such as recording/reproducing, preparation/transmission, and separation/recording. The claims as written are indefinite because it is unclear whether the claim requires one or both of the limitations.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. **Claims 1, 2, 6, 8-13, 17, 19-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teagarden et al., (U.S. 6,694298) in view of Toyoda, (U.S. 6,441,916).**

3. As per claim 1, Teagarden discloses a medical information processing system comprising: two or more medical information processing apparatuses connected to the

Internet for transmitting patient information from one of the two or more medical information processing apparatuses to the other medical information processing apparatuses by e-mail via the Internet, (Teagarden, Fig. 10; col. 11, lines 17-35; col. 12, lines 28-31; col. 14, lines 23-39)

wherein each of said medical information processing apparatuses includes data recording/reproducing means which has a database and data processing means which connects to at least one medical information processing terminal provided with a medical inspection apparatus, (Teagarden, Fig. 1B, Fig. 10; col. 11, lines 17-35; col. 12, lines 13-31; col. 13, lines 45-52; col. 14, lines 23-39)(receiving and/or storing is considered to be analogous to recording/reproducing).

each of said medical information terminals is provided to be able to input the patient information and data obtained by said medical inspection apparatus to said database of said data recording/reproducing means and interrelates said data accompanying said patient information, (Teagarden, col. 12, lines 13-31)(disclosing condition-specific charts and graphs that are a form of image data).

Teagarden fails to disclose the following well-known features of e-mail transmission provided by below reference to Toyoda.

each of said data processing means has a program to perform an automatic preparation/transmission so as to be capable of automatically checking whether there is new patient information or image data newly added or stored in the database of automatically preparing e-mail to which said new patient information or image data and a patient ID are attached if there is said new patient information or image data newly

added and stored in the database, and of automatically transmitting the e-mail to said other medical information processing apparatuses, based on a predetermined setting condition, (Toyoda, col. 4, lines 8-18), and

to perform and automatic separation/recording so as to be capable of, if an e-mail to which new patient information or image data is received from one of said other medical information processing apparatuses, automatically separating said new patient information or image data from said e-mail and of automatically storing said separated patient information or image data in said database, (Toyoda, col. 4, lines 8-18), and

image data, (Toyoda, Fig. 5, col. 3, lines 57-60), and

a medical information processing system, wherein the setting condition is a set capacity of data transmittable as the e-mail, (Toyoda, col. 1, line 10 - col. 2, line 27, col. 5, line 15-col. 6, line 64) (disclosing e-mail limited by set capacity of data, i.e. 1 MB).

It would be obvious to one of ordinary skill in the art in view of Toyoda to make the setting condition correspond to a set capacity of data transmittable as the e-mail. The motivation would be to have a successful data transmission, (Toyoda, col. 1, line 63-col. 2, line 27).

4. As per claim 2, Teagarden discloses a medical information processing system according to claim 1, wherein the new information in the database is any one of new data newly added, changed data and partially deleted information, (Teagarden, Col. 17, lines 5-36) (clinical professional calls the patient and utilizes the new information to

complete a post patent call clinical evaluation to be added to the database and transmitted to the patient's primary doctor).

Teagarden fails to disclose image data, therefore Toyoda is added to show this well-known feature, (Toyoda, Fig. 5, col. 3, lines 57-60)

5. As per claim 6, Teagarden fails to disclose a medical information processing system, wherein the set capacity is set based on a mailbox having a smaller capacity between mailboxes on the transmission side and the receiving side. However, such a system is well-known in the art as evidenced by Toyoda, (Toyoda, col. 1, line 10 - col. 2, line 27; col. 3, line 43-col. 4, line7; col. 5, line 15-col. 6, line 64) (disclosing e-mail limited by storage capacity of server and mailbox).

It would be obvious to one of ordinary skill in the art at the time of the invention to make the set capacity dependant upon the capacity of the smaller mailbox. The motivation would be to have a successful data transmission, (Toyoda, col. 1, line 63-col. 2, line 27).

6. As per claim 8, Teagarden fails to disclose an information processing system, wherein said data processing means is set to prepare a transmission message file to the effect that the e-mail has been transmitted when automatically preparing the e-mail, and to transmit the transmission message file to any one of the other information processing apparatuses and facsimiles placed in places where the information processing apparatuses are located via a transmission route different from a

transmission route of the e-mail. However, such a system is well known in the art as evidenced by Toyoda, (Toyoda, Fig. 1, Fig. 3; col. 1, lines 50-55; col. 2, line 53- col. 3, line 55; col. 4, line 12-col. 6, line 64) (disclosing transmission-related processing including analysis and storage corresponding to error and delivery notification, disclosing periodically accessing mail server to download new e-mail, and disclosing sending a reply message to the administrator instead of the sender, i.e. a different transmission route).

It would be obvious to one of ordinary skill in the art at the time of the invention to combine the medical data processed by Teagarden with the system of Toyoda. The motivation would be to have a successful data transmission, (Toyoda, col. 1, line 63-col. 2, line 27).

7. As per claim 9, Teagarden fails to disclose an information processing system, wherein the data processing means is set to prepare a list of transmission message files and to transmit the list to any of the other medical information processing apparatuses and the facsimiles placed in the places where the medical information processing apparatuses are located via the transmission route different from the transmission route of the e-mail at any of a certain specified time interval and a previously specified time. However, such a system is well known in the art as evidenced by Toyoda, (Toyoda, Fig. 1, Fig. 3; col. 1, lines 50-55; col. 2, line 53- col. 3, line 55; col. 4, line 12-col. 6, line 64) (disclosing transmission-related processing including analysis and storage corresponding to error and delivery notification, disclosing periodically accessing mail

server to download new e-mail, and disclosing sending a reply message to the administrator instead of the sender, i.e. a different transmission route).

It would be obvious to one of ordinary skill in the art at the time of the invention to combine the medical data processed by Teagarden with the system of Toyoda. The motivation would be to have a successful data transmission, (Toyoda, col. 1, line 63-col. 2, line 27).

8. As per claim 10, Teagarden fails to disclose an information processing system, wherein the data processing means is set to prepare a list of transmission message files and to transmit the list to the other medical information processing apparatuses via the same transmission route as a transmission route of the e-mail at any of a certain specified time interval and a previously specified time. However, such a system is well known in the art as evidenced by Toyoda, (Toyoda, Fig. 1, Fig. 3; col. 1, lines 50-55; col. 2, line 53- col. 3, line 55; col. 4, line 12-col. 6, line 64) (disclosing transmission-related processing including analysis and storage corresponding to error and delivery notification, and disclosing periodically accessing mail server to download new e-mail).

It would be obvious to one of ordinary skill in the art at the time of the invention to combine the medical data processed by Teagarden with the system of Toyoda. The motivation would be to have a successful data transmission, (Toyoda, col. 1, line 63-col. 2, line 27).

9. As per claim 11, Teagarden fails to disclose an information processing system, wherein the medical information processing apparatus is set to transmit reply mail to the effect that the list of the transmission message files has been received when receiving the list. However, such a system is well-known in the art as evidenced by Toyoda, (Toyoda, col. 1, lines 50-55; col. 4, line 12-col. 6, line 64)(disclosing sending a reply message to the administrator or sender and periodically accessing mail server to download new e-mail).

It would be obvious to one of ordinary skill in the art at the time of the invention to combine the medical data processed by Teagarden with the system of Toyoda. The motivation would be to have a successful data transmission, (Toyoda, col. 1, line 63-col. 2, line 27).

10. As per claim 23, Toyoda further discloses an information processing system wherein said program is configured to always check whether or not capacity of said image data or patient information in a medical folder reaches said set capacity, (Toyoda, col. 3, line 57-col. 4, line 18) (disclosing checking and recording file and transmission size and periodically accessing mail server to download new e-mail to avoid over-filling the data area that has a set capacity of 1MB).

11. As per claim 24, Teagarden discloses a medical information processing system comprising: two or more medical information processing apparatuses connected to the Internet for transmitting patient information from one of the two or more medical

information processing apparatuses to the other medical information processing apparatuses by e-mail via the Internet, (Teagarden, Fig. 10; col. 11, lines 17-35; col. 12, lines 28-31; col. 14, lines 23-39)

wherein each of said medical information processing apparatuses includes data recording/reproducing means which has a database and data processing means which connects to at least one medical information processing terminal provided with a medical inspection apparatus, (Teagarden, Fig. 1B, Fig. 10; col. 11, lines 17-35; col. 12, lines 13-31; col. 13, lines 45-52; col. 14, lines 23-39)(receiving and/or storing is considered to be analogous to recording/reproducing).

each of said medical information terminals is provided to be able to input the patient information and data obtained by said medical inspection apparatus to said database of said data recording/reproducing means and interrelates said data accompanying said patient information, (Teagarden, col. 12, lines 13-31)(disclosing condition-specific charts and graphs that are a form of image data), and

wherein the setting condition is any one of a specified time interval and a previously specified time, (Teagarden, col. 2, lines 39-52) (disclosing selecting records for analysis based on specified time period that would include both a specific interval and time.)

Teagarden fails to disclose the following well-known features of e-mail transmission provided by below reference to Toyoda.

each of said data processing means has a program to perform an automatic preparation/transmission so as to be capable of automatically checking whether there is

new patient information or image data newly added or stored in the database of automatically preparing e-mail to which said new patient information or image data and a patient ID are attached if there is said new patient information or image data newly added and stored in the database, and of automatically transmitting the e-mail to said other medical information processing apparatuses, based on a predetermined setting condition, (Toyoda, col. 4, lines 8-18), and

to perform and automatic separation/recording so as to be capable of, if an e-mail to which new patient information or image data is received from one of said other medical information processing apparatuses, automatically separating said new patient information or image data from said e-mail and of automatically storing said separated patient information or image data in said database, (Toyoda, col. 4, lines 8-18), and

image data, (Toyoda, Fig. 5, col. 3, lines 57-60).

It would be obvious to one of ordinary skill in the art in view of Toyoda to make the setting condition correspond to a set capacity of data transmittable as the e-mail. The motivation would be to have a successful data transmission, (Toyoda, col. 1, line 63-col. 2, line 27).

12. As per claims 12, 13, 17, 19-22, Teagarden discloses a recording medium wherein programs for said medical information processing system are stored, (Teagarden, Fig, 8; col. 12, line 64-col. 13, line 8).

All other claim limitations disclosed by applicant are substantially similar to limitations disclosed in claims 1, 2, 6, 8-11, respectively. Therefore, the grounds for the

rejection of claims 1, 2, 6, 8-11 are herein incorporated by reference against claims 12, 13, 17, 19-22.

Response to Arguments

Applicant's arguments with respect to claims 1, 2, 6, 8-13, 17, and 19-24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell S. Glass whose telephone number is 571-272-3132. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RSG
8/20/2007

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